



Docket No.: 511582003500  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:

Mary FARIS, et al.

Application No.: 09/809,638

Filed: March 14, 2001

For: 125P5C8: A TISSUE SPECIFIC PROTEIN  
HIGHLY EXPRESSED IN VARIOUS  
CANCERS

Art Unit: 1643

Examiner: A. Harris

**DECLARATION BY INVENTORS**  
**UNDER 37 C.F.R. § 1.131**

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

We, the undersigned, declare as follows:

1. We are co-inventors of claims 1, 14 and 23, currently pending in the above-referenced application. The claims relate to an isolated 125P5C8 protein comprising the sequence of SEQ ID NO: 2 or a polynucleotide sequence encoding the codons for SEQ ID NO: 2, which is exemplified by the nucleotide sequence of SEQ ID NO:1.

2. The Office rejected claims 1, 14 and 23 as allegedly being anticipated by WO 200270539 A2, which was filed March 5, 2002. This PCT application claims priority to U.S. Application No. 09/799,451, which was filed March 5, 2001, and is now U.S. Patent No. 6,783,989.

A copy of WO 200270539 was submitted in an Information Disclosure Statement provided in this application mailed on April 5, 2001. This document discloses sequence 1397 which is identical to SEQ ID NO: 2 of the present application.

3. We reduced the claimed invention to practice in the United States prior to the date U.S. Patent No. 6,783,989 was filed (March 5, 2001).

4. This reduction to practice is evidenced by a true and accurate copy of an email message sent to various members of the scientific staff by inventor Steve C. Mitchell on January 3, 2001. The email provides the nucleic acid and amino acid sequences of the material encompassed by the claims in the above-referenced patent application. A copy of this email is provided as Exhibit A.

5. The nucleotide sequence disclosed in Exhibit A consists of 2,103 nucleotides and 699 amino acids.

6. Exhibit B shows a comparison of the nucleotide sequence of SEQ ID NO:1 and the nucleotide sequence disclosed in Exhibit A. Every single nucleotide disclosed in SEQ ID NO:1 is present in the nucleotide sequence disclosed in Exhibit A. Accordingly, the email of Exhibit A clearly demonstrates the that nucleotide sequence of SEQ ID NO:1 was in our possession prior to the earliest priority date to which WO 200270539 (the cited art) is entitled to claim.

7. Exhibit C shows a comparison of the amino acid sequence of SEQ ID NO:2 and the amino acid sequence disclosed in Exhibit A. Every single amino acid residue disclosed in SEQ ID NO: 2 is present in the amino acid sequence disclosed in Exhibit A. Accordingly, the email of Exhibit A clearly demonstrates the that amino acid sequence of SEQ ID NO:2 was in our possession prior to the earliest priority date to which WO 200270539 (the cited art) is entitled to claim.

8. In view of the email provided as Exhibit A and the analysis of the sequences disclosed therein and shown in Exhibits B and C, we declare that the invention of the pending claims was reduced to practice in the United States prior to March 5, 2001, the earliest priority date available to the cited document.

We declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

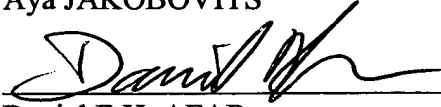
Date	Executed at	
<u>01/26/2006</u>	<u>Santa Monica, CA</u> (City/State)	<u>Aya Jakobovits</u> Aya JAKOBOVITS
_____	_____ (City/State)	_____ Daniel E.H. AFAR
_____	_____ (City/State)	_____ Steve Chappell MITCHELL
<u>1/27/06</u>	<u>Santa Monica, CA</u> (City/State)	<u>Pia M. Challita-Eid</u> Pia M. CHALLITA-EID
<u>1-27-06</u>	<u>Santa Monica CA</u> (City/State)	<u>Arthur B. Raitano</u> Arthur B. RAITANO
_____	_____ (City/State)	_____ Mary FARIS

8. In view of the email provided as Exhibit A and the analysis of the sequences disclosed therein and shown in Exhibits B and C, we declare that the invention of the pending claims was reduced to practice in the United States prior to March 5, 2001, the earliest priority date available to the cited document.

We declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date

Executed at

<u>2/1/2006</u>	<u>(City/State)</u> <u>FREMONT, CA</u> <u>(City/State)</u>	<u>Aya JAKOBOVITS</u>  <u>Daniel E.H. AFAR</u>
<u>                    </u>	<u>(City/State)</u>	<u>Steve Chappell MITCHELL</u>
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<u>                    </u>	<u>(City/State)</u>	<u>Mary FARIS</u>

**Popp, Shane**

From: Mitchell, Steve  
Sent: Wednesday, January 03, 2001 1:43 PM  
To: Scientists  
Subject: 125P5C8 reagents.

Colleagues,

The Company reagent for 125P5C8 (124P1B7/139P3A1) is pasted. It is a PCR based pCR2.1/TA clone(prostate) with three point differences from the Japanese (colon) reported hypothetical sequence.  
Two point are conserved for translation whereas the third point difference gives an amino acid change near the 3 prime end. This is verified with genomic sequencing.

>125P5C8(124P1B7/139P3A1) pCR2.1 subclone

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>125P5C8(124P1B7/139P3A1) pCR2.1 subclone

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